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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

FINEMAN, LEE A

ART UNIT PAPER NUMBER

2872

DATE MAILED: 01/13/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/748,196

Applicant(s)

OUCHI, YUMIKO

Examiner

Lee Fineman

Art Unit

2872

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 November 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 7-9, 11 and 12 is/are rejected.
- 7) ☒ Claim(s) 6, 10, 13-14 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 08 November 2002 is: a) ☒ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 7.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Drawings

1. The corrected or substitute drawings were received on 8 November 2002. These drawings are acceptable.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 11 and 12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The definitions of dH and dL are incomplete as they only define the distance from a starting point (i.e. the center of the lens surface) but not to a finishing point. As a result, the metes and bounds of the conditions found in these claims are unascertainable.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-2, 4-5, 7-8 and 11-12 are rejected under 35 U.S.C. 102(b) as being anticipated by Osa et al., PCT No. WO99/12068.

Art Unit: 2872

Regarding claims 1, and 11, Osa et al. discloses a stereomicroscope (fig. 6) comprising an illumination unit (LH) for illuminating a specimen (S) with light, a specimen setting board (not numbered, fig. 30), a fitting member (T) for fitting an objective lens (31), the illumination unit, specimen setting board and fitting member are disposed in sequence on an optical axis (fig. 30), wherein one of a predetermined low-magnification objective lens and a higher-magnification objective lens than the low-magnification objective lens is selected and fitted as the objective lens to the fitting member, the illumination unit includes a light source (20), a shield element (40a, 40b) for cutting off partially light beam emitted from the light source, first and second condenser lenses for converging the light beam passing the shield element on the specimen and a mechanism for selecting one of the first and second condenser lenses and disposing the selected condenser lens on the optical axis (26), the first condenser lens (fig. 35B) exhibits an optical characteristic of setting a position conjugate to an entrance pupil (P1, fig. 35B) of the low-magnification objective lens fitted to the fitting member in a position of the shield element (74a, 74b) or in the vicinity of the shield element and the second condenser lens (fig. 35A) exhibits an optical characteristic of setting a position conjugate to an entrance pupil (P1, fig. 35A) of the high-magnification objective lens fitted to the fitting member in a position of the shield element or in the vicinity of the shield element wherein the position conjugate to the entrance pupil of the low-magnification objective lens formed by the first condenser lens and the position conjugate to the entrance pupil of the higher-magnification objective lens formed by said second condenser are substantially same (figs. 35A and 35B). In as much as claim 11 is able to be understood in light 35 U.S.C 112 rejection made above, Osa et al. meets the structural requirements set forth and therefore anticipates claim 11.

Regarding claims 2 and 12, Osa et al. further discloses a first condenser lens for converging the light beam passing the shield element on the specimen and a mechanism for moving the first condenser lenses on and off the optical axis (26), the shield element is disposed in a position of an entrance pupil or in the vicinity of the entrance pupil of the high-magnification objective lens as the objective lens fitted to the fitting member and the first condenser lens exhibits an optical characteristic of setting a position conjugate to an entrance pupil of the low-magnification objective lens fitted to the fitting member in a position of the shield element or in the vicinity of the shield element (figs. 35A and 35B). In as much as claim 12 is able to be understood in light 35 U.S.C 112 rejection made above, Osa et al. meets the structural requirements set forth and therefore anticipates claim 12.

Regarding claims 4, 7 and 8, Osa et al. further discloses the illumination unit including a collector lens (21, fig. 30) disposed between said light source and said shield element and the collector lens forms an image of the light source in a position of the shield element, and a reflecting element for bending the optical axis (24) disposed between the shield element and the first or second condenser lens (fig. 30). Osa et al. also discloses the shield element including a stretchable light shield member and a mechanism for stretching and contracting the light shield member (figs 25A & B, 26A & B) in at least so far as stretchable is defined as to extend in length.

Regarding claim 5, Osa et al. further discloses a reflecting element for bending the optical axis (430, fig 39A) disposed in the position of the shield element (435) of the illumination unit (300) and the shield element has a cover member for covering a part a reflecting surface of the reflecting element.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 3 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Osa et al.

Regarding claim 3, Osa et al. further discloses a zoom-stereomicroscope where the shield element is disposed in a position conjugate to the entrance pupil or in the vicinity of the entrance pupil of the objective lens exhibits the lowest magnification (figs. 36 and 37) but the reference does not explicitly state a zoom lens including a movable lens movable in a direction of the optical axis in order to change a magnification. Official notice is taken that it is well known to one of ordinary skill in the art at the time the invention was made that a conventional zoom system includes a zoom lens with a movable lens movable in a direction of the optical axis in order to change a magnification. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention that the zoom-stereomicroscope of Osa et al. includes a zoom lens with a movable lens movable in a direction of the optical axis in order to change a magnification in that this system is readily available and can be easily obtained for use in manufacturing.

Regarding claim 9, Osa et al. discloses the claimed invention except for the converging angle of the light beam converged by the second condenser lens being larger than the aperture angle of the high-magnification objective lens. Official notice is taken that systems have a larger

Art Unit: 2872

converging angle of the light beam than the aperture angle are well known to one having ordinary skill in the art at the time the invention was made in order to avoid wasted light in the system. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made have to have the converging angle of the light beam converged by the second condenser lens being larger than the aperture angle of the high-magnification objective lens to avoid wasting light.

Allowable Subject Matter

8. Claims 6, 10, 13, and 14 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

9. The following is a statement of reasons for the indication of allowable subject matter:

Upon further reconsideration, claim 6 is allowable over the prior art for at least the reason that the prior art fails to teach and/or suggest “the shield element including a mechanism for increasing and decreasing a covered area of the reflecting surface by feeding out and drawing in the cover member above the reflective surface in order to adjust a quantity of the light beam to be cut off” as set forth in the claimed combination.

Osa et al. discloses a reflecting element for bending the optical axis (430, fig 39A) disposed in the position of the shield element (435) of the illumination unit (300) and the shield element has a cover member for covering a part a reflecting surface of the reflecting element but

Art Unit: 2872

does not have the cover member increasing or decreasing the covered area by a feeding-out or drawing-in mechanism as claimed.

Upon further reconsideration, claims 10, 13, and 14 are allowable over the prior art for at least the reason that the prior art fails to teach and/or suggest “where a reflectance of the front end portion of the cover member is larger than the reflectance of other portions thereof” as set forth in the claimed combination.

Osa et al. discloses a reflecting element for bending the optical axis (430, fig 39A) disposed in the position of the shield element (435) of the illumination unit (300) and the shield element has a cover member for covering a part a reflecting surface of the reflecting element but does not have the cover member having portions wherein the reflectance of the front end portion of the cover member is larger than the reflectance of other portions thereof as claimed.

Response to Arguments

10. Applicant's arguments with respect to claims 1-14 have been considered but are moot in view of the new ground(s) of rejection.

Applicant argues that Osa et al. does not teach or suggest “wherein the position conjugate to the entrance pupil of the low-magnification objective lens formed by the first condenser lens and the position conjugate to the entrance pupil of the higher-magnification objective lens formed by said second condenser are substantially same.” The examiner respectfully disagrees. As illustrated in figs. 35A and 35B, the positions of light shield members (74a and 74b) as well as the entrance pupil (P1) for both magnifications are substantially same.

Art Unit: 2872

Conclusion


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lee Fineman whose telephone number is (703) 305-5414. The examiner can normally be reached on Monday - Friday 7:30 - 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cassandra Spyrou can be reached on (703) 308-1687. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9318 for regular communications and (703) 872-9319 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4900.


LAF

January 8, 2003


MARK A. ROBINSON
PRIMARY EXAMINER